

REMARKS**1. Specification Amendments.**

The Examiner objected to the specification for minor informalities. The specification has been amended to correct for such informalities. Support for such amendments can be found in the original claims as filed. No new matter has been added.

Applicant notes that the Examiner objected to the specification for failing to recite "attachment means." Applicant notes that this term is defined in the specification, for example, on page 9, line 1, through page 10, line 3.

Applicant further notes that the term "Internal structure," which the Examiner objected to, also is defined in the specification, for example on page 6, lines 8-15 and on page 7, line 18 through page 8, line 11.

2. Claim Amendments.

Claim 1 has been amended to correct for informalities and in light of the Examiner's rescission of the allowable subject matter of the previous office action. Specifically, Claim 1 has been amended to clarify that the device is attached to a water structure (as defined in the specification) and that the end pieces structurally comprise attachment means for securing the end pieces to the water structure. Support for this clarification can be found on page 9, line 16 through page 10, line 3 of the original Specification. Further, we thank the Examiner for pointing out the interchangeable use of the terms "supporting structure" and "water structure". Claim 1 has been amended to use only the term "water structure" such that the claim language is parallel.

Claims 2 and 3 have not been amended in this Response.

Claim 4 was previously cancelled.

Claims 5 and 6 have been amended to use only the term "water structure" such that the claim language is parallel.

Claims 7 and 8 were previously cancelled.

Claim 9 has been amended to correct for informalities. Specifically, Claim 9 has been amended to clarify that the device is attached to a water structure (as defined in the specification) and that the end pieces structurally comprise attachment means for securing the end pieces to the water structure. Support for this

clarification can be found on page 9, line 16 through page 10, line 3 of the original Specification.

Claims 10 - 13 have not been amended in this Response.

Claims 14 and 15 have been amended to use only the term "water structure" such that the claim language is parallel.

Claim 16 was previously cancelled.

Claim 17 has been amended to correct for informalities. Specifically, Claim 17 has been amended to clarify that the device is attached to a water structure (as defined in the specification) and that the end pieces structurally comprise attachment means for securing the end pieces to the water structure. Support for this clarification can be found on page 9, line 16 through page 10, line 3 of the original Specification.

Claim 18 was previously cancelled.

Claim 19 has been amended to correct for informalities. Specifically, Claim 19 has been amended to clarify that the device is attached to a water structure (as defined in the specification) and that the end pieces structurally comprise attachment means for securing the end pieces to the water structure. Support for this clarification can be found on page 9, line 16 through page 10, line 3 of the original Specification.

Claim 20 has been amended to correct an antecedent basis issue.

Claims 21-30 have not been amended in this Response.

Claims 31-33 have been added due to the new grounds of rejection in the Office Action. The prior Office Action indicated allowable subject matter and the claims were amended in accordance with that Office Action. As the current Office Action rescinded the allowance, these claims resurrect some of the subject matter of the previously canceled claims. Support for new Claim 31 can be found in original Claim 4. Support for new Claim 32 can be found in original Claim 7. Support for new Claim 33 can be found in original Claim 18 and FIGs. 1 and 6.

No new matter has been added in any of these amendments.

3. 35 USC 102 Anticipation.

Claims 1-3, 5, 6, 17, 19-23 and 25-30 have been rejected under 35 USC 102(b) as being anticipated by US Patent No. 5893179 to Johnson (Johnson '179). Claims 1-3, 5, 6, 9-15, 17, and 19-30 have been rejected under 35 USC 102(b) as

being anticipated by US Patent No. 5537696 to Chartier (Chartier '696). Applicant respectfully submits that neither Johnson '179 nor Chartier '696 anticipate the currently amended claims.

Anticipation under 35 USC 102(b) requires "the disclosure in a prior art reference of each and every element of the claimed invention." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); *see also verdegall Bros. V. Union Oil Co. of California*, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). The absence of one element from the cited prior reference negates anticipation. *See Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 USPQ2d 409 (Fed Cir. 1984). As discussed below, each and every element of the claims of the present patent application is *neither* found in Johnson '179 *nor* in Chartier '696.

a. US Patent No. 5893179 To Johnson Does Not Anticipate The Present Invention As Disclosed And Claimed.

Currently amended Claim 1 includes limitations that the end pieces comprise attachment means (element 110 as shown in the figures and discloses on page 9, line 16 through page 10, line 3 of the original Specification) and **"the first end piece and the second end piece are structured to hold the elongated member at a distance from the water structure so that the device functions as a handle for a user of the supporting structure."** Applicant submits that Johnson '179 fails to disclose such elements and that this claim is therefore allowable. Further, Applicant can ascertain no impetus that a person of ordinary skill in the art would modify Johnson '179 such that it met the above conditions as there would be no benefit to the waterfall device of Johnson '179 by so spacing it. This is not unexpected, as there is no reason to suspect that Johnson '179 intended to teach a waterfall handle as in the present invention.

Further, Claims 2, 3, 5, and 6 depend from independent Claim 1 and are therefore allowable for the same reasons that Claim 1 is allowable.

Claims 9-15 were not rejected over Johnson '179.

Currently amended Claim 17 also includes the limitations that the end pieces comprise attachment means and **"the first end piece and the second end piece are structured to hold the elongated member at a distance from the supporting structure so that the device functions as a handle for a user of the supporting**

structure." Applicant submits that Johnson '179 fails to disclose such elements and that this claim is therefore allowable.

Currently amended Claim 19 also includes the limitations that the end pieces comprise attachment means and **"the first end piece and the second end piece are structured to hold the elongated member at a distance from the supporting structure** so that the device functions as a handle for a user of the supporting structure." Applicant respectfully submits that Johnson '179 fails to disclose such elements and that this claim is therefore allowable.

Further, Claims 20-23 and 25-30 depend from independent Claim 19 and they are similarly allowable for the same reasons that Claim 19 is allowable.

Claim 24 was not rejected over Johnson '179.

Claims 31-32 depend from independent Claim 1 and are allowable for the same reasons that Claim 1 is allowable as stated above (they are new).

Claim 33 depends from independent Claim 9 and is new. As can be seen in FIGs. 1 and 6, the end pieces hold the elongated center section at a distance from the water structure and there is a space between the elongated center section and the water structure for accommodating the user's hand.

For the above reasons, Applicant requests that the Examiner remove the rejections and find the claims allowable.

b. US Patent No. 5537696 To Chartier Does Not Anticipate The Present Invention As Disclosed And Claimed.

Claims 1-3, 5, 6, 9-15, 17, and 19-30 have been rejected under 35 USC 102(b) as being anticipated by US Patent No. 5537696 to Chartier (Chartier '696). Applicant respectfully submits that Chartier '696 does not anticipate the currently amended claims.

As discussed above, anticipation under 35 USC 102(b) requires "the disclosure in a prior art reference each and every element of the claimed invention." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); *see also verdegall Bros. V. Union Oil Co. of California*, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). The absence of one element from the cited prior reference negates anticipation. *See Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224

USPQ2d 409 (Fed Cir. 1984). As discussed below, each and every element of the claims of the present patent application is *not* found in Chartier '696.

Chartier '696 discloses a waterfall which is mounted to a sidewall or under the decking of a pool. More specifically, Chartier '696 discloses that the "invention relates to **modules incorporated in the side walls** and connected to the plumbing of swimming pools..." Column 1, lines 13-14 (emphasis added). Chartier '696 also indicates that, in a preferred embodiment, **the back portion of the device is "adapted to fit into and form part of the pool structure."** Column 1, lines 56-57 (emphasis added). Finally, FIG. 5 of Chartier '696 (reproduced below), illustrates the "apparatus installed in a typical environment." Column 2, line 45.

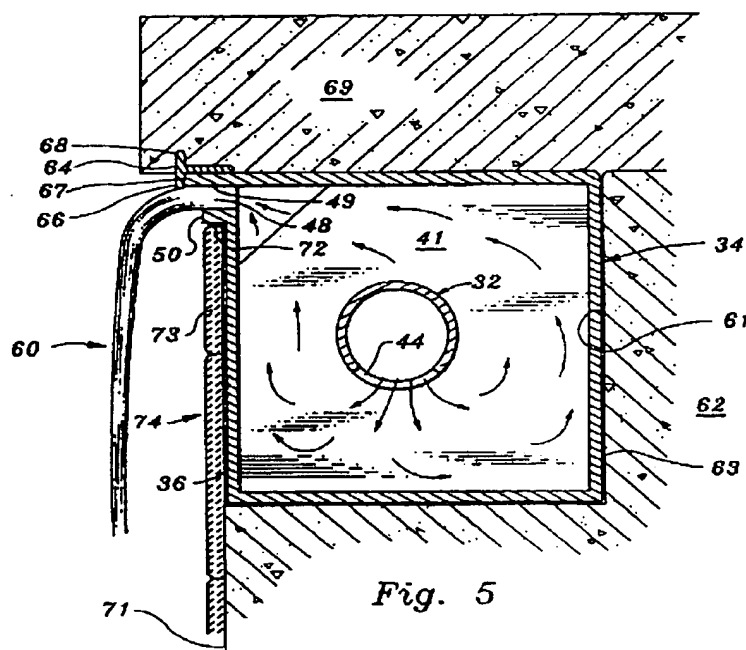


Figure 1: Chartier '696

As disclosed, the device of Chartier '696 is installed directly into the wall of the pool and there is no space between the device and the pool wall. Further, as shown, the device would not be suitable as a handle as it is situated under pool decking and/or flushly affixed to a wall.

As further disclosed in Chartier '696:

Since the apparatus of the present invention provides a sheet waterfall by a short, overhanging upper lip construction, as previously described, economies of construction, without a sacrifice of strength, are obtained. In other words, **as appears most clearly in FIG. 5, the manifold 34 is readily fitted into a pre-cut notch 61 in the bond beam 62 around the perimeter of the pool or spa and secured with a bonding layer 63 of thin set concrete.**

If desired, an elongated key 64, T-shaped in transverse section, can be positioned horizontally so that one arm 66 of the T-shaped key 64 abuts the outer end 67 of the upper lip 49 and the other arm 68 of the key is located within a keyway formed in the beam 69, or deck coping. **Since the front portion 36 of the manifold 34 is flush with the pool or spa wall surface 71,** the lower face 72 of the lower lip 50 provides an ideal upper abutment for the top course 73 of tile 74. **Because of the short length of the lips 49 and 50 and the vertically co-planar construction of the outermost surfaces of the lower lip 50 and the tile 74, the sheet waterfall 60 appears to emerge directly from the tile and presents a most appealing visual effect.** At the same time, as a result of the short length of the lips, compact structural integrity and strength are maintained.

Chartier '696, column 6, lines 1-23 (emphasis added).

Applicant respectfully submits that the disclosure of Chartier '696 not only fails to teach the elements of Applicants pending claims, but also that Chartier '696 is not suitable to function as a handle as recited in Applicants claims. As indicated by the **bold** text above, Chartier '696 teaches a permanent mounting of the device either into the wall of the pool itself and/or teaches having an additional surface over the top of the device such that the waterfall appears to "emerge directly from the tile", whereas Applicants waterfall emerges from the device itself which is fashioned as a handle.

Applicant also notes that currently amended claim 1 includes the limitations that the end pieces comprise attachment means and **"the first end piece and the second end piece are structured to hold the elongated member at a distance from the supporting structure so that the device functions as a handle for a user of the supporting structure"**, which are not found in Chartier '696. Applicant

can ascertain no impetus that a person of ordinary skill in the art would modify Chartier '696 such that it met the above conditions as there would be no benefit to the waterfall device of Chartier '696 by so spacing it. This is not unexpected, as there is no reason to suspect that Chartier '696 intended to teach a waterfall handle as in the present invention. Applicant respectfully submits that Chartier '696 fails to disclose such elements and that this claim is therefore allowable.

Further, Claims 2, 3, 5, and 6 depend from independent Claim 1 and are therefore allowable for the same reasons that claim 1 is allowable.

Currently amended Claim 9 includes the limitations that the end pieces comprise attachment means and **"the elongated member is rotatable within the first end piece and the second end piece and the rotation of the elongated member varies the direction of the waterfall."** Applicant respectfully submits that the device of Chartier '696 does not disclose such elements. As noted above, Chartier '696 discloses a permanently mounted waterfall device "secured with a bonding layer 63 of thin set concrete", thus it does not teach a device that is rotatable as in the pending claim.

Further, Claims 10-15 depend from independent Claim 9 and are therefore allowable for the same reasons that Claim 9 is allowable.

Currently amended claim 17 includes the limitations that the end pieces comprise attachment means and **"the first end piece and the second end piece are structured to hold the elongated member at a distance from the supporting structure** so that the device functions as a handle for a user of the supporting structure." Applicant respectfully submits that Chartier '696 fails to disclose such elements and that this claim is therefore allowable.

Currently amended Claim 19 includes the limitations that the end pieces comprise attachment means and **"the first end piece and the second end piece are structured to hold the elongated member at a distance from the supporting structure** so that the device functions as a handle for a user of the supporting structure." Applicant respectfully submits that Chartier '696 fails to disclose such elements and that this claim is therefore allowable.

Further, Claims 20-23 depend from independent Claim 19 and they are similarly allowable for the same reasons that Claim 19 is allowable.

As stated above, Applicant respectfully submits that the disclosure of Chartier '696 does not disclose a rotatable device as in pending Claim 24, and this claim is allowable.

Claims 25-30 depend from independent Claim 19 and they are similarly allowable for the same reasons that Claim 19 is allowable.

Claims 31-32 depend from independent Claim 1 and are allowable for the same reasons that Claim 1 is allowable as stated above (they are new).

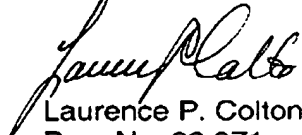
Claim 33 depends from independent Claim 9 and is allowable for the reasons stated above, i.e., Chartier '696 fails to disclose each element of the claim. In particular, Applicant notes that the device of Chartier '696 is not rotatable, nor does it disclose a device wherein "the first end piece and the second end piece are structured to hold the elongated member at a distance from the supporting structure so that there is a cavity between the elongated member and the supporting structure and the device functions as a handle for a user of the supporting structure." For these reasons, this claim is allowable.

For the above reasons, Applicant requests that the Examiner withdraw the grounds for rejection and find the pending claims allowable.

CONCLUSION

Applicant submits that the claims are in condition for allowance and respectfully requests such action. If the examiner has any questions that can be resolved over the telephone, the examiner is invited to contact the below-signed attorney of record.

Respectfully submitted,
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